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EXAMINER

HAMILTON, LALITA M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/721,640
Filing Date: November 25, 2003
Appellant(s): MILLER ET AL.

Ronald Reichman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 28, 2008 appealing from the Office action mailed November 15, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,496,991	Delfer	3-1996
5,586,036	Pintsov	12-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delfer (5,496,991) in view of Pintsov (5,586,036).

Delfer discloses an automated remittance method comprising giving one or more bills in the form of one or more mail pieces to a bill recipient, placing a code by a creditor on one or more bills that references the bill recipient, the bill recipient's account number and amount due on a face of the mail piece, mailing the bill by the bill recipient, creating an electronic funds transaction for the amount indicated in the code between the bill recipient's bank account and the creditor's bank account, and transferring funds from the bill recipient's bank account to the creditor's bank account (col.4, lines 1-30); a first code that references the bill recipient's account number and amount due and a

second code that references the location of the bill recipient (col.4, lines 15-30 and fig.1-all); the first code is a Planet code and the second code is a Postnet bar code (col.4, lines 15-30 and fig.1-all—codes contain all information applicable); indicating on the mail piece after funds have been transferred to the creditor's bank account from the bill recipient's bank account that the bill has been paid (col.4, lines 1-30); delivering the mail piece indicating that the bill has been paid to the bill recipient (col.4, lines 1-30—well-known and practiced to send receipts to customers via mail); the first code references a record in a data base that references the bill recipient's bank account, amount due, the account being paid, and the second code represents the physical location of the bill recipient (col.4, lines 15-30 and fig.1-all); the first code indicates that an electronic funds transaction will take place (col.4, lines 1-30); code placed by the creditor indicates the minimum amount that is due (col.4, lines 1-30); the code placed by the creditor indicates the entire amount that is due (col.4, lines 1-30); code placed by the creditor indicates an amount greater than the minimum amount that is due is going to be paid (col.4, lines 1-30); placing an indication on the bill by the bill recipient that indicates the amount greater than the minimum amount that is due is going to be paid (col.4, lines 1-30—may be authorized on approval card); and delivering a billing mail piece from a creditor to a bill recipient, the billing mail piece including a bill and a bill-paying return mail piece, receiving the bill-paying return mail piece mailed by the bill recipient, the bill-paying return mail piece having a code printed thereon that identifies at least one of the bill recipient and the bill an amount due on the face of the mail piece, recipient's account number and scanning the code on the bill-paying return mail piece,

and initiating an electronic funds transaction for the amount indicated in the code from the bill recipient's bank account to the creditor's bank account (col.4, lines 1-30 and fig.1-all). Delfer does not disclose scanning by the post the code on the mail piece before the mail piece is delivered to the creditor. Pinstov teaches a postage payment system whereby the post may scan the mail piece and a payment may be made by electronic funds transfer (col.8, lines 25-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Pinstov within Delfer for the motivation of demonstrating that an alternative source may scan the mail piece and create the electronic funds transfer for the bill payment.

(10) Response to Argument

The Appellant argues that neither Delfer nor Pinstov disclose or teach scanning by the post the code on the mail piece before the mail piece is delivered to the creditor; creating an electronic funds transaction for the amount indicated in the code between the bill recipient's bank account and the creditor's bank account; or transferring funds from the bill recipient's bank account to the creditor's bank account. In response, Delfer discloses the following:

- (a) giving one or more bills in the form of one or more mail pieces to a bill recipient (col.4, lines 1-30);
- (b) placing a code by a creditor on one or more bills that references the bill recipient, the bill recipient's account number and amount due on a face of the mail piece (identifying information for use in electronic transfer stored in codes-- col.4, lines 1-30);

(c) mailing the bill by the bill recipient (col.4, lines 1-30);

(e) creating an electronic funds transaction for the amount indicated in the code between the bill recipient's bank account and the creditor's bank account

(Consumer indicates that they would like to utilize electronic transfer of funds to the appropriate vendor, and sends in approval cards. The information contained in stored in identifying codes, which may be scanned to process electronic transfer of funds--col.4, lines 1-30); and

(f) transferring funds from the bill recipient's bank account to the creditor's bank account (Once the transfer is initiated, the funds are transferred to the appropriate vendor account--col.4, lines 1-30).

Delfer does not disclose:

(d) scanning by the post the code on the mail piece before the mail piece is delivered to the creditor.

Pintsov teaches scanning by the post the code on the mail piece before the mail piece is delivered to the creditor (The bill is received by the carrier, and code is scanned to authorize payment—col.8, lines 25-40).

The Examiner found it to have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Pintsov within Delfer for the motivation of demonstrating that an alternative source may scan the mail piece and create the electronic funds transfer for the bill payment.

The Appellant argues that neither reference discloses or teaches indicating on a mail piece that funds have been transferred to the creditor's bank account indicating that

the bill has been paid and delivering the mail piece to the recipient. In response, Delfer discloses that the remittance document contains information indicating amounts owed, services rendered or other similar events, which may include information indicating that the bill was paid, which would be reflected in the balance on the remittance document--col.5, lines 35-50 and col.4, lines 1-30).

The Appellant argues that neither reference discloses or teaches the placing of codes on the face of a mail piece that indicate the amounts that are due (entire amount, minimum amount, and amount greater than minimum amount). In response, Delfer discloses that the remittance document contains information indicating amounts owed, services rendered or other similar events--col.5, lines 35-50 and col.4, lines 1-30).

The Appellant argues that neither Delfer nor Pintsov disclose or teach delivered a billing mail piece from a creditor to a bill recipient, the billing mail piece including a bill and a bill paying return mail piece. In response, Delfer discloses a bill and a remittance document (col.4, lines 1-30, 50-62).

The Appellant argues that neither Delfer nor Pintsov disclose or teach indicating on the face of a return mail piece that the bill has been paid or indicating the physical location of the bill recipient in the second code. In response, Delfer discloses indicating on the face of a return mail piece that the bill has been paid In response, Delfer discloses that the remittance document contains information indicating amounts owed, services rendered or other similar events, which may include information indicating that the bill was paid, which would be reflected in the balance on the remittance document (col.5, lines 35-50 and col.4, lines 1-30) and indicating the physical location of the bill

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recipient in the second code (The information contained in stored in identifying codes, including addresses--col.4, lines 1-30).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lalita M Hamilton/

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Conferees:

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